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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUY TCHAO

Appeal 2007-4229
Application 09/472,490
Technology Center 1700

Oral Hearing Held: January 16, 2008

Before TEDDY S. GRON, ADRIENE LEPIANE HANLON and CAROL A. SPIEGEL, *Administrative Patent Judges*.

| * * * *

The above-entitled matter came on for hearing on Wednesday, January 16, 2008, commencing at 9:34 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown, Notary Registration No. 7066896, Notary Public.

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A P P E A R A N C E S

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5ON BEHALF OF THE APPELLANT:

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P R O C E E D I N G S

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THE USHER: Calendar Number 15, Appeal Number 2007-

174229, Mr. Salvatore Abbruzzese.

18

JUDGE GRON: Mr. Whosie?

19

MR. ABBRUZZESE: Abbruzzi is fine.

20

JUDGE GRON: Counsel, this is Appeal Number 2007-4229

21for reissue of U.S. Patent 5601997, Tchao. And it is for Chemotaxis Assay

22Procedure. You have 20 minutes. Proceed.

23

MR. ABBRUZZESE: Thank you. Salvatore Abbruzzese from

24Hoffmann & Baron. I represent Dr. Tchao and also Becton Dickinson, who

25is the exclusive licensee of the patent in the application in question.

26

The present reissue application on appeal includes several

27issues, some of which have been resolved during the prosecution or will be

28resolved pending the outcome of this appeal. For example, there are no prior

29art rejections remaining in this case. Also, a new declaration and terminal

1 disclaimer will be filed pending a successful outcome on the appeal.

2 The primary unresolved issue before you is the rejections under
3 35 USC Sections 251 and 112, first paragraph. Both of these rejections are
4 based on the same premise. Is the claimed subject matter sought by reissue
5 the same invention disclosed in the patent? Stated another way, is the scope
6 of the reissue claimed supported by the specification of the original patent?

7 What this case is not is a case of recapture. The scope of the
8 claims on appeal here have not been given up during prosecution and that is
9 not even being contended by the examiner.

10 The primary inquiry under section 251 is whether one skilled in
11 the art reading the specification could identify the subject matter of the
12 reissue claimed as being disclosed by the patentee in the original application.

13 The inquiry under section 251 is the same as the written
14 description requirement under section 112, first paragraph. The reissue
15 statute, 35 USC section 251, is acknowledged to be remedial in nature. It is
16 based on the fundamental principles of fairness and equity and the Court
17 compelled the statute should be construed liberally.

18 Broad reissue is permitted to cover an embodiment which is not
19 disclosed by the original patent and only discovered later. As long as the
20 disclosure reasonably conveys to one skilled in the art that the applicant had
21 in his possession the invention at the time of the patent.

22 The Federal Circuit wrestling with this issue --

23 JUDGE GRON: All the claims in the patent are to chemotaxis
24 --

25 MR. ABBRUZZESE: Chemotaxis assay.

26 JUDGE GRON: -- assay.

27 MR. ABBRUZZESE: That is correct.

1 JUDGE GRON: And your argument, therefore, is that that
2doesn't limit the assay procedure.

3 MR. ABBRUZZESE: That is correct. The disclosure is all
4based --

5 JUDGE GRON: We are supposed to disregard that term?

6 MR. ABBRUZZESE: No, no, no, no, no. Not at all. What I'm
7urging here is that you have to look at what the invention is that the
8applicant had at the time of disclosure. My contention is that --

9 JUDGE GRON: The claimed invention or the invention
10disclosed in the spec?

11 MR. ABBRUZZESE: The invention disclosed in the spec.
12Because that is what -- they didn't have it in his possession at the time of
13disclosure. Obviously, we wouldn't be here if we were looking at it in the
14claims. This is a broad reissue.

15 By definition, we are looking for claimed scope, which is
16beyond what we originally claimed. We have filed within two years and
17we're entitled to broaden the claims of the application as long as we can
18show that the invention is within the possession of the applicant at the time
19he filed his disclosure.

20 My contention is that the invention is a nondestructive assay
21procedure for measuring cell migration across a membrane. That is what the
22specification entails. In essence, that is the invention.

23 Of course, the applicant described this with specificity to a
24chemoattractant. So in the bottom well of the plate, he puts a chemical agent
25which produces the cell migration-labeled cells on the opposite side of the
26membrane.

1 But the invention is not limited to that. The invention is the
2 novel assay nondestructive of cell and the novel membrane which allows
3 cell migration from one well to the other. That is what we're seeking by the
4 broad reissue.

5 The prior art doesn't show that. The examiner never contends
6 that we're trying to recapture something that we gave up during prosecution.

7 And according to the case law, reissue must be applied
8 liberally; therefore, we believe we're entitled to the claim of claim 46, the
9 scope of claim 46, which, in essence, describes a novel, nondestructive assay
10 procedure for labeling, for measuring labeled cells, which have migrated
11 through a membrane.

12 JUDGE SPIEGEL: Counsel, when was the underlying patent
13 issued? The issue date was?

14 MR. ABBRUZZESE: Bear with me one second.

15 JUDGE SPIEGEL: Okay.

16 MR. ABBRUZZESE: February 11th, 1997.

17 JUDGE SPIEGEL: What is two years after February 11th,
18 1997?

19 MR. ABBRUZZESE: February 11th, 1999.

20 JUDGE SPIEGEL: When was your application filed?

21 MR. ABBRUZZESE: December -- I don't have the original
22 application date. I only have the -- this is a continuation case on a reissue
23 application that has issued where we corrected other errors. There is no
24 issue that we're outside the two-year scope.

25 JUDGE SPIEGEL: So you're relying on the date of the --

26 MR. ABBRUZZESE: Yes. I'm sorry. I didn't know what you
27 were getting at.

1 JUDGE SPIEGEL: I just wanted to clarify that.

2 MR. ABBRUZZESE: There is a parent application, which we
3 filed within two years. There was several errors in this case, some of which
4 related to the originally-filed claims, and then there was the issue of a
5 broadening reissue.

6 The examiner allowed the first set of claims, rejected the
7 broadened claims under 251, 112, first paragraph. So what we did was we
8 filed a continuation to the broadened claims to prosecute that separately and
9 allowed the parent patent to issue. So we claim direct priority to an
10 application which was filed within two years of the issue date of the patent
11 in question.

12 JUDGE SPIEGEL: Because that chain of dates is not terribly
13 clear on the record. No offense.

14 MR. ABBRUZZESE: I know. We had very difficult
15 prosecution. I mean, it is not relevant here, but I can explain it to you.

16 We've had several briefs be filed before you and bounce back
17 either because the examiner having not done something or the applicant not
18 having done something. So I think this is about the fourth brief I've filed in
19 this case never reaching oral argument stage.

20 It kept getting returned to us for various informalities. So I can
21 understand the confusion in tracking the prosecution in this, but I can assure
22 you that this claim is direct priority to an application which was filed within
23 two years of the issue date.

24 That is why the issue of whether or not we're entitled to
25 broaden the claims has never come up. It is only whether or not the
26 specification supports the broadened claim that we're trying to get.

1 JUDGE SPIEGEL: And the examiner believes that you are not
2enabled to go for these claims?

3 MR. ABBRUZZESE: That is correct.

4 JUDGE SPIEGEL: And your position is you are because of
5this membrane you have?

6 MR. ABBRUZZESE: Yes.

7 JUDGE SPIEGEL: Are you saying it is not that or are you
8saying it is the apparatus? I'm not quite clear.

9 MR. ABBRUZZESE: The method claim. It is the method of
10measuring nondestructive cell migration.

11 JUDGE SPIEGEL: Correct.

12 MR. ABBRUZZESE: And what we do here is we labeled cells
13in the upper chamber and then --

14 JUDGE SPIEGEL: So you have a radiation opaque membrane?

15 MR. ABBRUZZESE: That is correct.

16 JUDGE SPIEGEL: Chemotaxis -- sorry. You can have cell
17taxis based on migration to the light.

18 MR. ABBRUZZESE: Correct.

19 JUDGE SPIEGEL: That clearly wouldn't work here.

20 MR. ABBRUZZESE: Sure, it would.

21 JUDGE SPIEGEL: Why? If it is a radiation opaque membrane
22--

23 MR. ABBRUZZESE: It is depending on the wavelength of
24light. You could have one wavelength that would allow certain labeled cells
25to migrate and then measure it with a radiation of a different wavelength.
26And your membrane just has to block the wavelength of your measuring
27radiation.

1 JUDGE SPIEGEL: Okay. And you would maintain that one of
2ordinary skill in the art can situate this membrane such that it would allow
3cell migration to be trapped when the attractant, if you will, it could be
4barometric pressure or gravity or water or --

5 MR. ABBRUZZESE: -- electricity.

6 JUDGE SPIEGEL: No. Just to be clear. Those are things that
7are within ordinary skill in the art and you're saying I don't have to give
8examples or I don't have to tell you how to do it. In fact, I don't have to give
9examples at all, and I shouldn't be limited to the example I gave because all
10the rest of this stuff is within ordinary skill. Am I understanding correctly?

11 MR. ABBRUZZESE: Absolutely. I couldn't have said it
12better. There are a number of different taxis assays. You named several of
13them. The examiner named several, was able to tell me right off the bat that
14these all exist.

15 What I'm saying is we know they exist, everybody knows they
16exist. It wouldn't take any undue experimentation to use instead of the
17chemical attractant, gravity, electricity, light. Any of the other various taxis
18assays well known in this area and develop.

19 The membrane is resistive to the wavelength of electromagnetic
20radiation used to measure the labeled cells that have migrated. That is the
21invention. The fact that we don't false measure the labeled cells that have
22not migrated and we have the nondestructive aspect of this is important.

23 Prior to this, if you didn't use a membrane of this type, you had
24to scrape away the cells that haven't migrated to avoid getting a false
25positive. We don't do that. That is clearly set forth in the specification, and
26I believe it is the real gist of the invention.

1 JUDGE SPIEGEL: The thing is, your specification, it sort of
2hammers home the point that, for example -- do you have a copy?

3 MR. ABBRUZZESE: I sure do.

4 JUDGE SPIEGEL: In column 1 --

5 MR. ABBRUZZESE: I have it.

6 JUDGE SPIEGEL: In column 1, lines 5 through 8, this relates
7to chemotaxis assay procedures and the background discusses, then, the
8disadvantages of chemotaxis assays and says that -- in column 2, lines 33
9through 36, it is talking about, this is a chemotaxis assay which avoids the
10above disadvantages. Disadvantages specifically related to chemotaxis.

11 MR. ABBRUZZESE: Correct.

12 JUDGE SPIEGEL: Column 2, line 44 talks about the chemical
13agent. Column 3, line 35 talks about the chemotaxis procedure of the
14invention.

15 MR. ABBRUZZESE: No argument from me. Absolutely
16correct.

17 JUDGE SPIEGEL: We've got this dichotomy here where the
18whole thrust of the specification appears to lead you to we're talking about
19chemotaxis.

20 MR. ABBRUZZESE: I don't disagree with you on that, but
21what we have to look at and what the case law says we look at is, what is the
22invention? And the invention is not limited to chemotaxis. It is the
23embodiment known by the inventor at the time he came up with this.

24 But at all times, he recognized the fact that it was a novel
25membrane in a nondestructive assay.

26 I refer you to column 5 of the specification carrying over to
27column 6 where they talk about the invention and they talk about the

1membranes permitting measurement of the radiation from the labeled cells
2that migrated through the radiation opaque membrane. The whole paragraph
3doesn't mention chemotaxis.

4 It talks about cell migration, radiation opaque membrane.
5Someone reading that could certainly say, I can use gravity to affect that. I
6could use electricity. I could use other wavelengths of light. This just
7happened to be described for use with a chemical attractant.

8 JUDGE GRON: Has the examiner made any showing in this
9case to back up his statement that any of these other procedures would be
10not enabled, he alleges they are not, but do you know if there is other
11information --

12 MR. ABBRUZZESE: I have found none. The examiner -- one
13of my contentions is the examiner merely makes the statement that undue
14experimentation would be necessary and she didn't --

15 JUDGE GRON: Did he point to any references?

16 MR. ABBRUZZESE: She didn't support it at all.

17 JUDGE GRON: None at all. Who has the burden of proof in
18this case?

19 MR. ABBRUZZESE: I would think the examiner would
20because the reissue statute is positive in nature in that it says you shall be
21entitled to.

22 JUDGE GRON: Any more? Thank you, Counsel.

23 MR. ABBRUZZESE: Thank you very much.

24 (Whereupon, the proceedings at 9:49 a.m. were concluded.)

1 CERTIFICATE OF REPORTER

2 I, Dawn A. Brown, do hereby certify that the foregoing
3proceedings were taken by me in stenotype and thereafter reduced to
4typewriting under my supervision; that I am neither counsel for, related to,
5nor employed by any of the parties to the action in which these proceedings
6were taken; and further, that I am not a relative or employee of any attorney
7or counsel employed by the parties hereto, nor financially or otherwise
8interested in the outcome of the action.

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Dawn A. Brown